

Application No.: 10/596,412
Filing Date: June 13, 2006

REMARKS

Claims 51-98 are now pending. Claims 1-50 have been canceled without prejudice or disclaimer. The claims have been rewritten for clarity. Support for new claims 51-98 is found throughout the specification, *e.g.*, as indicated in Table 1 below:

Table 1

New Claim	Support
51	Original claim 14 and former claim 17
52	Original claim 14 and former claim 17; pages 19-20 of application and the Examples
53	Original claim 14 and former claim 17; pages 19-20 of application and the Examples
54	Page 57, line 9 of application
55	Page 19, line 10-16 of application
56	Original claim 12
57	Page 20, lines 9-10 of application
58	Page 20, lines 6-15 of application
59	Original claim 3
60	Original claim 5
61	Original claim 7
62	Original claim 9
63	Original claim 13
64	Original claims 2-4, 7-9, compound 10, page 13 of application
65	Page 6, line 19, page 9, line 9, page 11, line 12 of application
66	Original claims 2-4, 7-9, compound 38, page 14 of application
67	Page 6, line 19, page 9, line 9, page 11, line 12 of application
68	Original claims 2-4, 7-9, compound 61, page 16 of application
69	Page 6, line 19, page 9, line 9, page 11, line 12 of application
70	Original claims 2-4, 7-9, compounds 38, 39, 61-71 and 73, pages 14 and 16 of application
71	Page 6, line 19, page 9, line 9, page 11, line 12 of application

Application No.: 10/596,412
Filing Date: June 13, 2006

72	Compound 73, page 16 of application
73	Compound 59, page 16 of application
74	Original claims 1, 8
75	Original claim 3
76	Original claim 4
77	Original claim 5
78	Original claim 7
79	Original claim 9
80	Original claim 11
81	Original claim 12
82	Original claim 13
83	Original claims 2-4, 7-9, compound 10, page 13 of application
84	Original claims 2-4, 7-9, compound 10, page 13 of application and page 20, lines 6-15 of application
85	Page 6, line 19, page 9, line 9, page 11, line 12 of application
86	Original claims 2-4, 7-9, compound 38, page 14 of application
87	Page 6, line 19, page 9, line 9, page 11, line 12 of application
88	Original claims 2-4, 7-9, compound 61, page 16 of application
89	Page 6, line 19, page 9, line 9, page 11, line 12 of application
90	Original claims 2-4, 7-9, compounds 38, 39, 61-71 and 73, pages 14 and 16 of application
91	Page 6, line 19, page 9, line 9, page 11, line 12 of application
92	Compound 61, page 16 of application
93	Compound 73, page 16 of application
94	Compound 59, page 16 of application
95	Page 20, lines 17-19 of application
96	Page 23, 1 st paragraph of application
97	Page 23, 1 st paragraph of application
98	Page 23, 1 st paragraph of application
99	Page 23, 1 st paragraph of application

Application No.: 10/596,412
Filing Date: June 13, 2006

Applicants gratefully acknowledge the Examiner's indication that all of the method claims directed to making compounds will be considered.

Applicants traverse the rejection of claims 17-22 and 36-46 under 35 U.S.C. §102(e) as anticipated by Chen (US 7,129,259). Claims 17-22 and 36-46 have been deleted so the rejection is moot. The Office appears to rely on Chen for disclosing an iodination process. Applicants respectfully submit that new Claims 51-52 are multi-step processes. In addition, Claims 53-99 do not recite an iodination step.

Applicants traverse the rejection of claims 17-22 and 36-46 under 35 U.S.C. §103 as obvious over Lee (US 6,689,779), Chen (US 7,129,259), Fukuda I (US 2005/0038092), II (US 2007/0185132) and Barbachyn I (US 5,523,403), II (US 5,565,571). Claims 17-22 and 36-46 have been deleted so the rejection is moot. According to MPEP §2116.01: "[i]nterpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation." Applicants respectfully submit that the present claims recite novel and nonobvious compounds.

In addition, upon the allowance of the elected method claims, Applicants respectfully request rejoinder of the withdrawn claims directed to compounds, compositions and methods of use. Applicants respectfully submit that rejoinder is supported by Example 2 in the TRAINING MATERIALS FOR TREATMENT OF PRODUCT AND PROCESS CLAIMS IN LIGHT OF IN RE BROUWER AND IN RE OCHIAI AND 35 U.S.C. 103(b) [hereinafter "Training Materials"]. Example 2 in its entirety is found in the Appendix attached hereto. In this example, a 4-way restriction requirement was made among claims directed to 1) a mold, 2) a method of producing an antibiotic using the mold, 3) an antibiotic, and 4) a method of treating a fungal infection using the antibiotic. In this example, the applicants elected the claims directed to the mold. However, during examination, the examiner determined that not only was a mold species allowable but also an antibiotic species. Thus, the examiner rejoined the claims directed to the antibiotic species. In addition, the examiner rejoined the claims directed to both of the methods of producing the antibiotic species and treating a fungal infection using the antibiotic species.

This example is germane to the present application because the Applicants respectfully submit that, in accordance with MPEP §2116.01, the Office is required to perform a claim

Application No.: 10/596,412
Filing Date: June 13, 2006

construction that treats language in the process claim which recites the making of a nonobvious compound as a material limitation. Therefore, as the Office must determine during the requisite claim construction whether the recited compounds claims are patentable, no undue burden will result from rejoining the corresponding compound claims. Applicants respectfully submit that the Training Materials support rejoining the nonobvious compound claims under these circumstances. Furthermore, if the compound claims are nonobvious, the Training Materials also support rejoining the composition and methods of using the nonobvious compounds. Thus, rejoinder of all of the withdrawn claims is respectfully requested upon allowance of the method claims.

Assuming, arguendo, that the subject matter of the withdrawn claims were pursued in a separate divisional application, the claims in the divisional application would fall under the safe harbor of 35 U.S.C. §121. Thus, for policy reasons, all of the claims should be considered in the present application.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Application No.: 10/596,412
Filing Date: June 13, 2006


In view of the foregoing comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If any questions remain, however, the Applicants respectfully request a telephonic interview so that any matters may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 11, 2009

By: 
Carolyn A. Favorito
Registration No. 39,183
Attorney of Record
Customer No. 20995
(949) 760-0404

Application No.: 10/596,412
Filing Date: June 13, 2006

Appendix

Excerpt from TRAINING MATERIALS FOR TREATMENT OF PRODUCT AND PROCESS CLAIMS IN LIGHT OF IN RE BROUWER AND IN RE OCHIAI AND 35 U.S.C. 103(b)

Example 2: Microbe/Fermentation

Claim 1. A biologically pure culture of any species of the genus *Aspergillus*.

Claim 2. The culture of claim 1 wherein the species is *Aspergillus nonsense* sp. having ATCC #99978.

Claim 3. A method of producing Antibiotic ZU-1289 comprising culturing any species of the genus *Aspergillus* capable of producing Antibiotic ZU-1289 under suitable conditions.

Claim 4. A method of producing Antibiotic ZU-1289ME comprising culturing *Aspergillus nonsense* sp. having ATCC #99978 under suitable conditions.

Claim 5. Antibiotic ZU-1289 (generic structure).

Claim 6. Antibiotic ZU-1289ME (specific structure).

Claim 7. A method of treating a fungal infection by topically administering the Antibiotic ZU-1289 of claim 5.

Claim 8. A method of treating a fungal infection by topically administering the Antibiotic ZU-1289ME of claim 6.

Assume the examiner finds it necessary to restrict the inventions under 35 U.S.C. 121. The examiner groups the inventions in the following manner:

Invention 1: claims 1 and 2 are directed to a genus starting material and to a species, respectively;

Invention 2: claims 3 and 4 are directed to methods of making a product using the starting materials recited in claims 1 and 2 respectively;

Invention 3: claims 5 and 6 are directed to a genus end product and to a species, respectively; and

Invention 4: claims 7 and 8 are directed to methods of using the products recited in claims 5 and 6 respectively.

The examiner makes a four-way restriction requirement between the products of claims 1 and 2; the methods of claims 3 and 4; the products of claims 5 and 6; and the methods of claims 7 and 8 pursuant to 35 U.S.C. 121.

Applicant elects to prosecute the products of claims 1 and 2. Claims 3-8 are withdrawn from further consideration under 37 CFR 1.142(b).

What is the status of the withdrawn process claims 3 and 4 if the product of claim 2 is determined to be allowable if rewritten in independent form, but the product of claim 1 is rejected over prior art under 35 U.S.C. 102?

In accordance with the Notice, withdrawn process claims which either depend from or otherwise include all the limitations of an allowed product claim will be rejoined when the product claim is found allowable. Therefore, upon allowance of product claim 2, the examiner must determine if any of the withdrawn process claims can be rejoined. In the above example, claim 4 would be rejoined since it includes the specific product limitations of allowable claim 2. Claim 3 would not be rejoined due to the distinction in scope between claim 3 and allowable claim 2.

If we add the following facts to the above scenario, does the answer change?

Application No.: 10/596,412
Filing Date: June 13, 2006

In conducting the examination, the examiner determines claim 2 to be allowable not only because the specific *Aspergillus* strain is not obvious over the anticipatory reference that has been applied to claim 1 or any other prior art on the microbe, but also because the specific structure of Antibiotic ZU-1289ME is not known or suggested in the prior art.

In this fact scenario the examiner should indicate that claims 4, 6 and 8 are all rejoined with claim 2, in that the antibiotic product has been determined to be allowable as well as the microbial product. Broad claims 3, 5 and 7 need not be rejoined since they are neither commensurate in scope with the allowable microbe or the allowable antibiotic compound.

Had product claims 5 and 6 been initially elected and claim 6 found to be allowable with claim 5 being rejected over prior art, claims 4 and 8 would be rejoined, but in this scenario product claim 2 would not be rejoined. The patentability of the microbe cannot rest alone on its ability to produce a product not previously known in the art, such as Antibiotic ZU-1289ME. The microbe may well have existed for a long period of time in the prior art and have been used for another purpose entirely. This cannot be determined without an appropriate search of the relevant microbial art. Claim 7 would not be rejoined since claim 5 was determined to be unpatentable.

6642812
021409